MED STATES PATENT AND TRADEMARK OFFICE UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov FIRST NAMED INVENTOR APPLICATION NO ATTORNEY DOCKET NO. CONFIRMATION NO. 10/671,026 Bruce Karsh 50269-0562 7849 **EXAMINER** 7590 05/09/2006 HICKMAN PALERMO TRUONG & BECKER, LLP FRISBY, KESHA 1600 WILLOW STREET ART UNIT PAPER NUMBER SAN JOSE, CA 95125

3715
DATE MAILED: 05/09/2006

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	10/671,026	KARSH ET AL.
Office Action Summary	Examiner	Art Unit
1	Kesha Frisby	3715
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tirn will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE!	I. the mailing date of this communication. D (35 U.S.C. § 133).
Status		
1) Responsive to communication(s) filed on 24 Se		
2a) ☐ This action is <b>FINAL</b> . 2b) ☑ This	action is non-final.	
3) Since this application is in condition for allowar	nce except for formal matters, pro	esecution as to the merits is
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.
Disposition of Claims		
4) ⊠ Claim(s) 1-14 is/are pending in the application. 4a) Of the above claim(s) is/are withdray  5) □ Claim(s) is/are allowed.  6) ⊠ Claim(s) 1-14 is/are rejected.  7) □ Claim(s) is/are objected to.  8) □ Claim(s) are subject to restriction and/o	wn from consideration.	
Application Papers		
9) ☐ The specification is objected to by the Examine 10) ☑ The drawing(s) filed on 9/24/2003 is/are: a) ☑ Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) ☐ The oath or declaration is objected to by the Ex	accepted or b) objected to by drawing(s) be held in abeyance. Se tion is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).
Priority under 35 U.S.C. § 119		
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority document 2. Certified copies of the priority document 3. Copies of the certified copies of the priority application from the International Burear * See the attached detailed Office action for a list	ts have been received. Is have been received in Applicat Irity documents have been receiv u (PCT Rule 17.2(a)).	ion No ed in this National Stage
Attachment(s)		
1) Notice of References Cited (PTO-892)	4) Interview Summan Paper No(s)/Mail D	
Notice of Draftsperson's Patent Drawing Review (PTO-948)     Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)     Paper No(s)/Mail Date		Patent Application (PTO-152)
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Art Unit: 3715

#### **DETAILED ACTION**

#### Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4-6 & 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 4 appears to be an abstract idea rather than a practical application of the idea. Claim 4 does not result in a physical transformation nor does it appear to provide a use, concrete and tangible result.

Therefore, claim 1 appears non-statutory. None of these dependent claims 4-6 & 11-13 correct this problem therefore they are also rejected. Please see MPEP 2106 for guidance.

#### Claim Rejections - 35 USC § 102

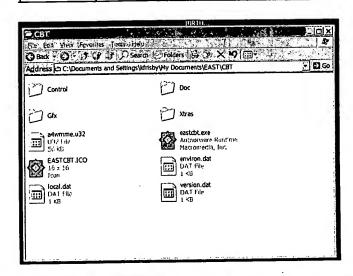
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

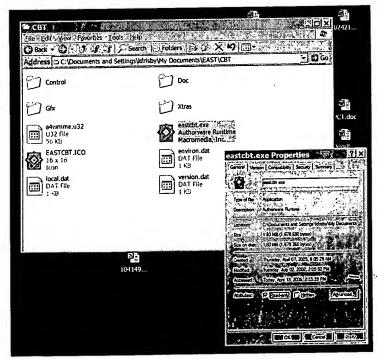
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 3. Claims 1-4, 7-11 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by East (SIRA: Search & Information Resources Administration at the United States Patent & Trademark Office). When rejecting these claims examiner viewed East as a whole, even though the literature submitted has different prior art dates.

Art Unit: 3715

However, the dates of the prior art documents were before the effective filling date (9/24/2003) of the applicant's application.



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The above screen shots have been provided to prove the date of the submitted information (PTO East Training documents dated (July 2, 2002)).

Here is an additional reference used for the rejection below:

Art Unit: 3715

The U.S. Patents Text Search Quick Reference Guide for East (1.1) (November 2000).

Referring to claim 1, East discloses receiving data that specifies a first form of a component word (input into BRS form, with the use of truncation, for example: fish\$); locating, within said compound word (for example, the compound word is fisherman), a second form of said component word (in this case, fisher) that differs from said first form of said component word (Once the browse button is pressed the words that are constructed from the use of the truncation fish\$ is highlighted); and displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word (the use of the Find function, such as, typing in fisher).

Referring to claim 2, East discloses wherein said second form of said compound word is a superlative form of said first form of said compound word (the examiner views this limitation as based on what the user is searching/trying to find will determine whether or not the compound word is in superlative form).

Referring to claim 3, East discloses wherein said second form (man) of said compound word (fisherman) does not contain said first form (fish) of said compound word (fisherman).

Referring to claim 4, East discloses (still working with the example above: fisherman) determining a first stem word (fish) associated with said compound word (fisherman); determining a second stem word (man) associated with said compound word (fisherman); based on a comparison between letters in said first stem word and said

Art Unit: 3715

compound word, determining a first starting position (starting with the letter "f"); based on a comparison between letters in said second stem word and said compound word, determining a second starting position (starting with the letter "m"); determining, based on said first starting position and said second starting position associated with said first stem word (starting with the letter "m"); and determining, based on said first starting position and said second starting position, an ending position associated with said first stem word (ending with the letter "h").

Referring to claim 7, East discloses further comprising: displaying said compound word with letters at (beginning with the letter "f") and between (letters "ish") said starting position associated with said first stem word (starting with the letter "f") and said ending position (ending with the letter "h") associated with said first stem word ("fish") visibly distinguished from the remainder of said compound word ("fisherman") (the word "fish" is lighted on the computer screen when using the Find function and typing in "fish"). Referring to claim 8, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 1 (see rejected claim 1). Referring to claims 9, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 2 (see rejected claim 2). Referring to claim 11, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors,

causes the one or more processors to perform the method of claim 3 (see rejected claim 3).

Referring to claim 11, East discloses a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 4 (see rejected claim 4).

Referring to claim 14, East discloses a computer-readable medium-carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 7 (see rejected claim 7).

#### Claim Rejections - 35 USC § 103

- 4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 5. Claims 5, 6, 12 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over East (SIRA: Search & Information Resources Administration at the United States Patent & Trademark Office) in view of Hull et al. (U.S. Publication Number 2003/0187886.

Referring to claim 5, East discloses the method of Claim 4. East does not disclose wherein determining said first starting position comprises: determining, for a first sequence of letters in said compound word, a first score based on how many letters in

Art Unit: 3715

said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score. East also does not disclose wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth. However, Hull et al. teaches determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score (paragraphs 0030 & 0031). Hull et al. also teaches wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth score (paragraphs 0030 & 0031). It would

Art Unit: 3715

have been obvious to one of ordinary skill in the art at the time the invention was made to include determining first, second, third and fourth sequences of letters, as well as, determining the first and second starting positions, as disclosed by Hull et al., incorporated into East in order to know where to start highlighting.

Referring to claim 12, East, as modified by Hull et al., teaches computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 5 (see rejected claim 5).

Referring to claim 13, East, as modified by Hull et al., teaches a computer-readable medium carrying one or more sequences of instructions which, when executed by one or more processors, causes the one or more processors to perform the method of claim 6 (see rejected claim 6).

#### Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

McGreevy (U.S. Publication Number 2003/0004914) teaches a system, method and apparatus for conducting a phrase search.

McGreevy (U.S. Publication Number 2002/0188587) teaches a system, method and apparatus for generating phrases from a database.

Hull et al. (U.S. Patent Number 6,671,684) teaches the use of scoring and highlighting within a document.

Art Unit: 3715

#### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kesha Frisby whose telephone number is 571-272-8774. The examiner can normally be reached on Mon. - Wed. 7-3pm, Thu. 6:30-4pm & Fri. 7-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewki can be reached on 571-272-6678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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RUBERT P. OLSZEWSKI

MINIOLOGY CENTER 3600 3700

## Notice of References Cited Application/Control No. 10/671,026 Examiner Kesha Frisby Applicant(s)/Patent Under Reexamination KARSH ET AL. Page 1 of 1

#### U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	Α	US-6,671,684	12-2003	Hull et al.	707/6
*	В	US-2002/0188587	12-2002	McGreevy, Michael W.	707/1
*	C	US-2003/0004914	01-2003	McGreevy, Michael W.	707/1
*	D	US-2003/0187886	10-2003	Hull et al.	707/203
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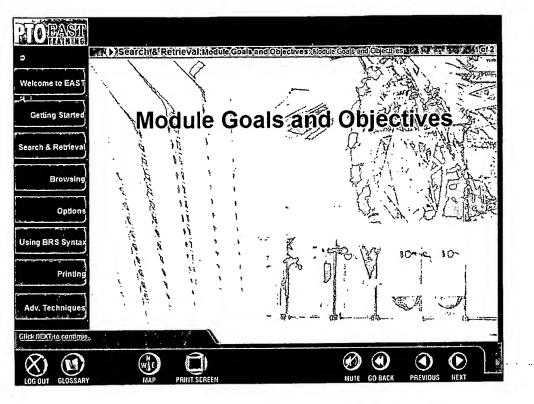
#### FOREIGN PATENT DOCUMENTS

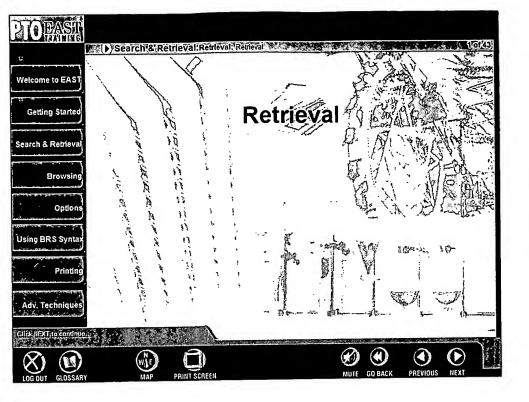
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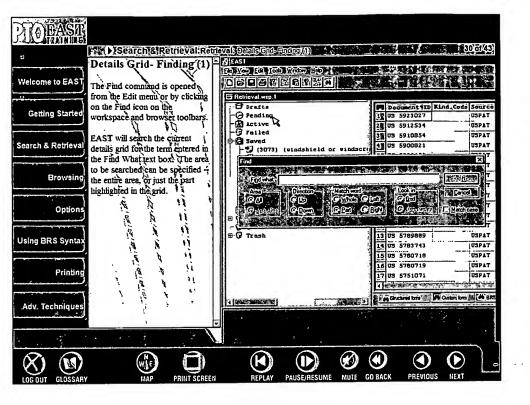
#### **NON-PATENT DOCUMENTS**

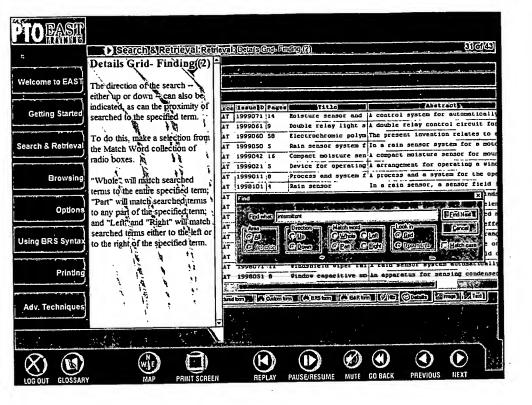
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	U	SIRA (Search and Information Resource Administration), PTO East Training, July 2, 2002, United States Patent aand Trademark Office (SIRA: Search and Information Resource Administration), Version 4.0.0.0, pgs 1-23.
	v	SIRA (Search and Information Resource Administration), U.S. Patents Text Search Quick Reference Guide for East (1.1), July November 2000, United States Patent aand Trademark Office (SIRA: Search and Information Resource Administration), Version 1.1, pgs 1-2.
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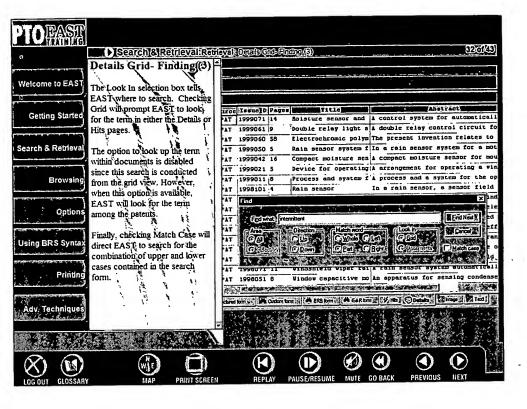
\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).) Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

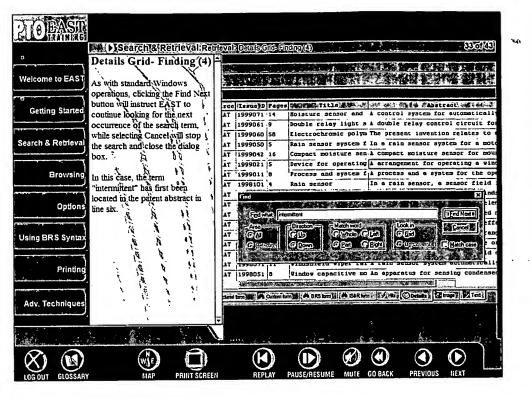




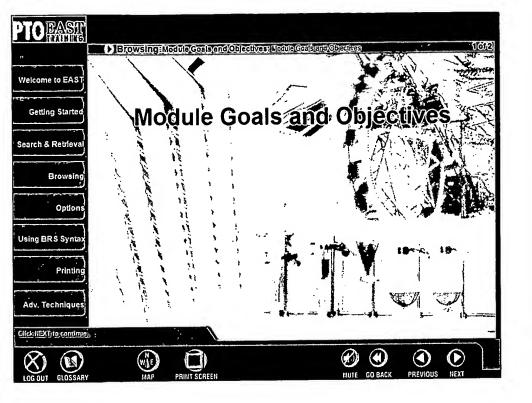


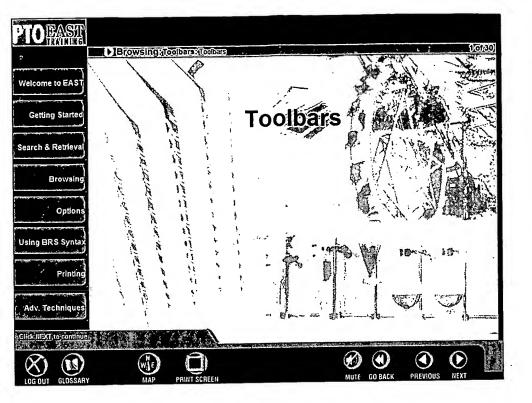


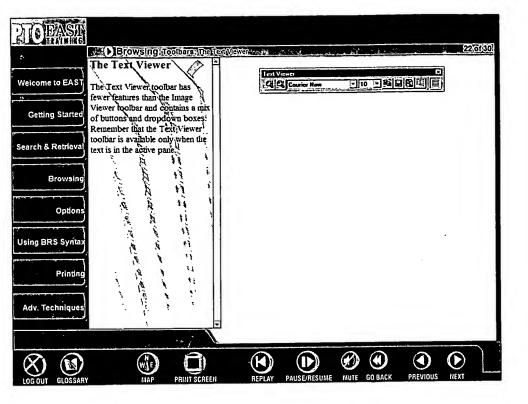


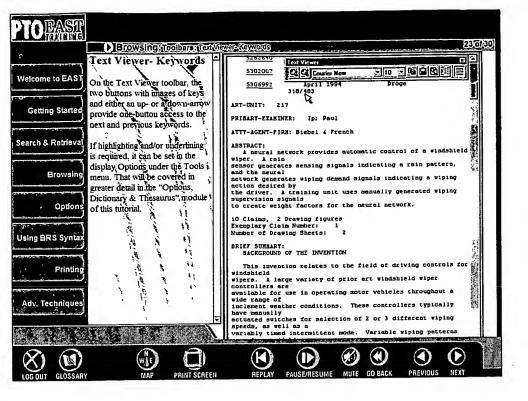


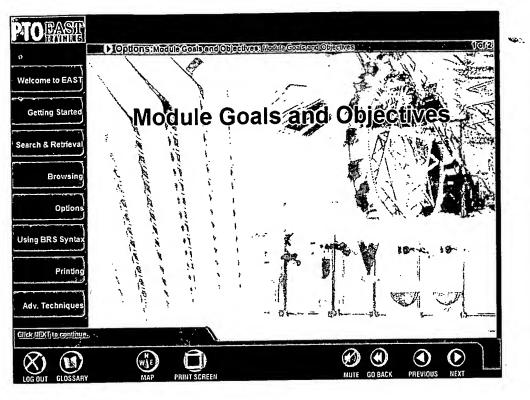
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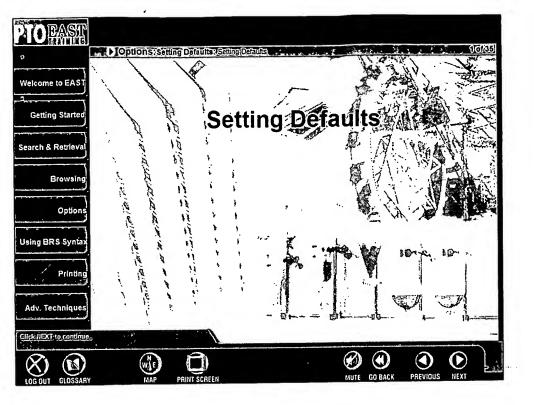


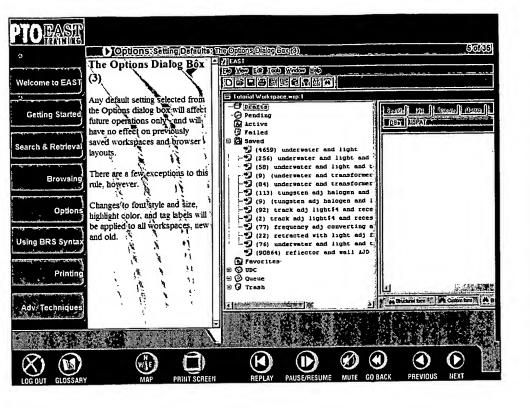


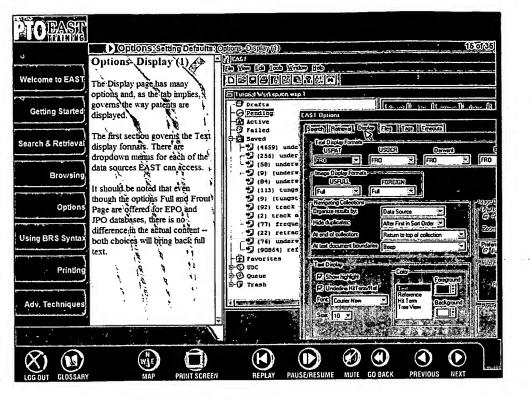


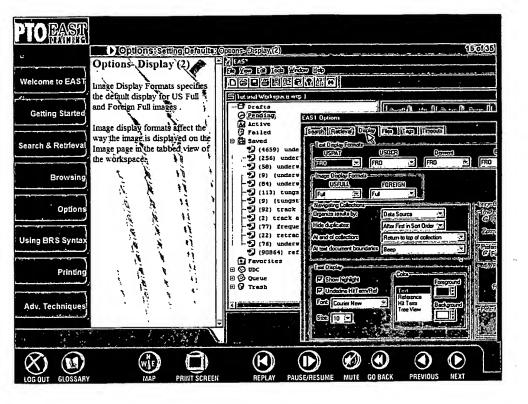


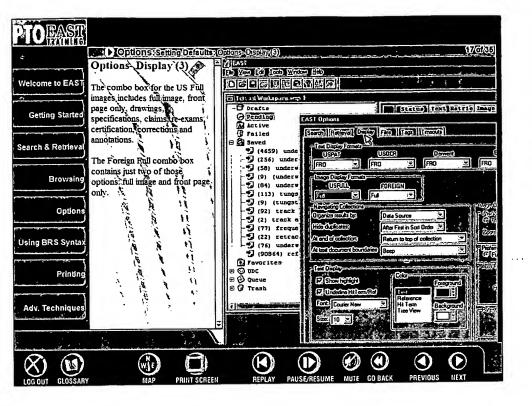




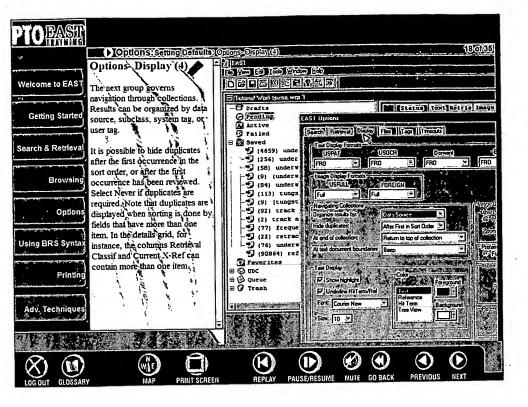


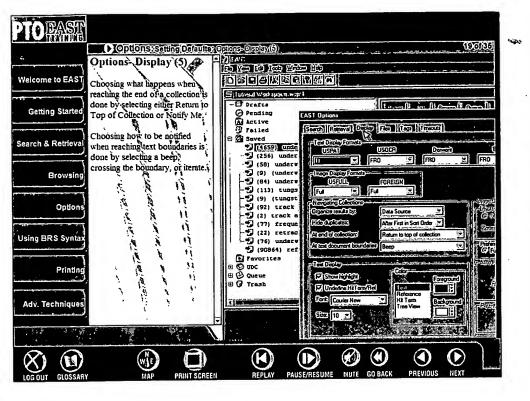






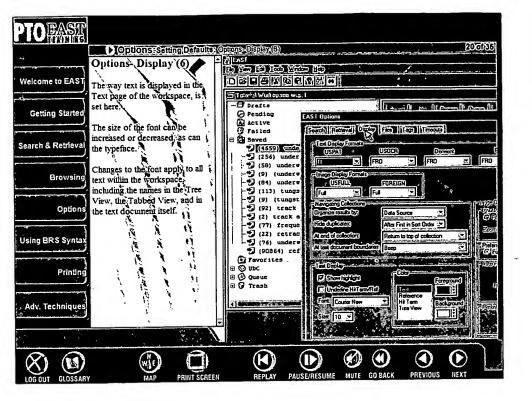
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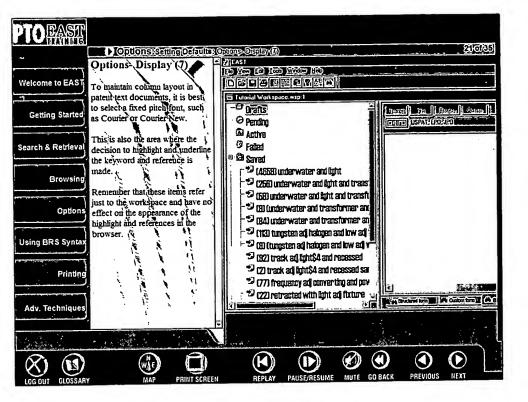




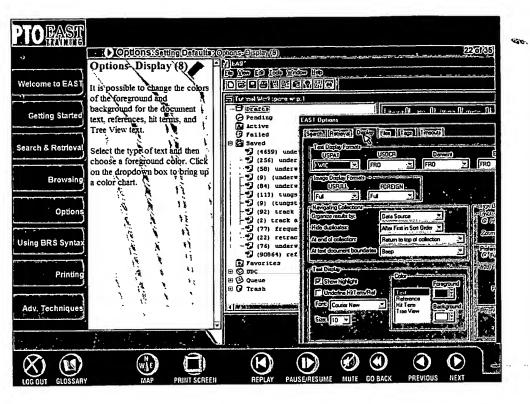
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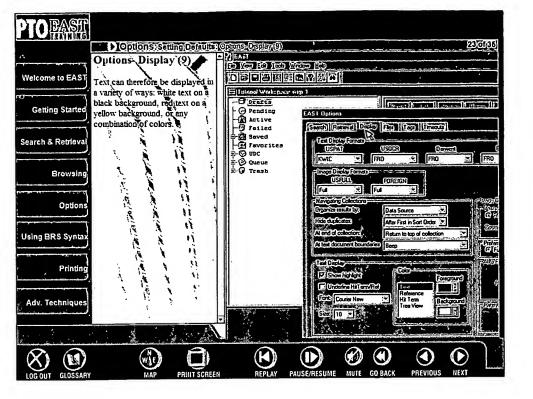


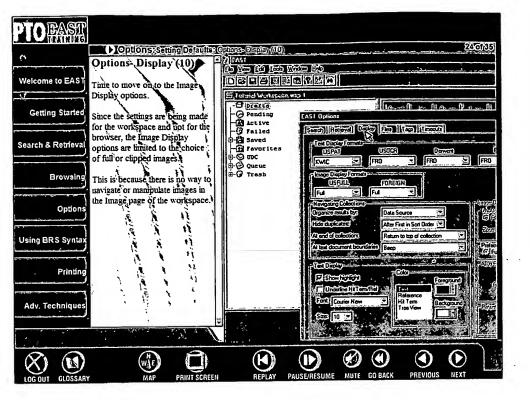


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Date (all relevant date information) Current Classification

References (Cited References, Field of Search)

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Searching Tips

DEFAULT OPERATORS

The default operator in WEST 2.0 can be set from Main Menu → Edit User Profile. User can set default to be OR, AND,

 Setting the plurals on in the USER PROFILE (from the main menu in WEST or from Tools/Options in EAST) will retrieve regular and irregular plurals, common The default operator in EAST 1.1 is the OR operator. It cannot be changed.

British spellings, and abbreviations. Example: L1 color (will retrieve color, colors, colour, colours)

▶ To retrieve words that may be single, hyphenated or two words, search: Example: L1 gamma\$1alumina or gamma adj alumina

non\$1skid or non adj skid

Avoid using simultaneous left and right truncation if possible since it takes a (will retrieve nonskid, non-skid, non/skid and non skid)

Example: L1 polymeriza\$6 or copolymeriza\$6 ong time to complete.

 Avoid truncation overflow by using limited truncation (\$n) Example: L1 modif\$8  Specific date/year searches are faster than date range searches. Example: L1 (1984 or 1985 or 1986 or 1987).py.

▼ To narrow a subject matter/assignee/inventor etc. to a specific type of patent such as Design, search:

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 Combine search statements using L numbers in either EAST or WEST Example: L1 not L2

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BRS allocates each user 270 Megabytes of 'in0' or intermediate storage space per search to process the query. An in0 File Overflow causes cancellation of the current search (and display of a warning):

Identify the common or broad terms in a search query or string of terms combined with "OR" and create one L-number for each of these concepts in the search

Combine the L-numbers. Temp File Overflow will still apply

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Type Code (S, P, E, H, i4, A)	AT. KD.	S.AT. (design)	Descriptive text (c/o ## Collins)	-	collins INTX			19960903.REPD.
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US Original class			Drawing Description	.DRWD.	pole.DRWD.	۸	@ad>19901231 @ad>=1007	
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<b>)</b>			The only data in this field is a "4", so "4", R47X, finds all patents to which Rule 47 applies.	"4".R47X. finds all	satents to which Rule 47 applies.	XOR (not enclosed in parentheses)		

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